

Rather, a heavy burden rests on the Office to clearly demonstrate the grounds for denying patentability. In this case, the Office has clearly not satisfied its evidentiary duty. For at least the reasons detailed in Appellants' Brief filed on November 7, 2002, and the additional arguments made *infra*, Appellants respectfully request that all rejections be reversed and withdrawn.

A. Group 1: Claims 78-82

The Office rejected Claims 78-82 under 35 U.S.C. § 103(a) as unpatentable over European Patent No. 0 842 652 A1 to Restle et al. ("*Restle*") in view of U.S. Patent No. 5,135,748 to Ziegler et al. ("*Ziegler*"). Appellants maintain that the Office has not established a prima facie case of obviousness with respect to these claims.

In attempting to refute the Appellants' allegation that the cited references do not teach "at least one nonionic polymer comprising at least one hydrophobic block and at least one hydrophilic block," the Office alleges that "[t]he nonionic amphiphilic lipids disclosed in the *Restle* reference in fact include polymers such as polysiloxane." *Answer*, p. 4.

B. Group 2: Claims 1-19, 21, 22, 30-62, 68-77, and 83

The Office has maintained the rejection of claims 1-19, 21, 22, 30-62, 68-77, and 83 as unpatentable over *Restle* in view of *Ziegler*. Appellants maintain that a prima facie case has not been established for the reasons set forth in the Appeal Brief filed November 7, 2002, as well as those below.

The Office continues to maintain the position that "[c]ationic polymers are well known in the cosmetic art, and that a skilled artisan using the cationic

polymers as taught by *Ziegler* would expect advanced moisturizing effect and stabilizing effect." *Answer*, p. 4.

1. The Prior Art Teaches the Presently Claimed Inventive Components Separately but Provides No Motivation for the Proposed Modification

The Office has failed to set forth any evidence establishing both a motivation to modify the cited references and a reasonable expectation of success in the proposed modification. Without such evidence, the Office cannot make out a *prima facie* case of obviousness. See Appellant's Brief filed on November 7, 2002 at pages 11-20, as well as the following arguments.

In order for an examiner to justify an obviousness rejection, he or she must provide "clear and particular" evidence of suggestion or motivation to combine the prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000). Such evidentiary support can be found most often in either the prior art references themselves or the knowledge generally available to one of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). In this case, the Office has not set forth any evidence, let alone "clear and particular" evidence, to substantiate the proposed modification.

First, the Office relies primarily on the knowledge of one skilled in the art to substantiate the rejection, but such reliance is not warranted in this case. General knowledge coupled with similar applicability cannot and should not render the present invention obvious. However, the Office relies on both these facts, i.e., that the references teach similar applications (emulsions) and that

cationic polymers are known in the art to reject the present invention. Under this standard, *any* component that is also useful in, for example, shampoo, would be obvious to combine with *any other* component that is also useful in shampoo, even without incentive to combine them. However, the law prescribes no such standard. Indeed, the Federal Circuit has consistently held that without proper motivation, a rejection based on prima facie obviousness is improper even if the combination of references taught every element of the claimed invention. See M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)). In view of the lack of motivation, one can objectively conclude that the Office has merely used the level of skill in the art “to act as a bridge over gaps in substantive presentations of an obviousness test.” *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999); *see also Appellant’s Brief* dated November 7, 2002, pages 14-18.

The above analogy also evidences the overbreadth of the Office’s rationale. Although the Office contends, to the contrary, that because “[t]he rejection was based on specific references meeting every limitation and an objective motivation to combine thereof,” its rationale is not overbroad. *Answer*, p. 6. This statement is simply incorrect. Appellants maintain that the Office’s underlying reasoning for combining the references would render many inventions obvious. As it would encompass essentially a modification of any composition by adding any component disclosed by *Ziegler* for any purpose, even purposes not taught by *Ziegler*. *See Appellant’s Brief* dated November 7, 2002, pages 14-16.

Further, Appellants continue to dispute the Office's reliance on U.S. Patent No. 6,120,757 to Dubief et al. ("*Dubief*") as evidence of "using cosmetic ingredients in different types[s] of formulations." *Answer*, p. 6. This "evidence" is simply irrelevant. Perhaps if *Dubief* disclosed that the presently claimed cationic polymers could be used in nanoemulsions or it disclosed that the claimed cationic polymers could be used with the claimed amphiphilic lipids, the Office could properly use this reference as evidence. But it does not. Thus, the Office's reliance on *Dubief* is both misplaced and unjustified.

Contrary to the Office's broad assertion, the issue is not whether cosmetic ingredients can be used in different formulations. But whether it would have been obvious to use the presently claimed cationic polymers as a component in "oil-in-water nanoemulsions comprising oil globules with an average size of less than 150 nm comprising at least one oil and at least one amphiphilic lipid." However, the Office has provided no such evidence of the obviousness of this modification.

Second, the cited references neither implicitly or explicitly suggest the presently claimed invention. In the *Answer*, the Office states that it clarified in the Advisory Action that the rejection "is based on the motivation to employ the specific beneficial ingredients in [the] *Ziegler* patent and not the entire emulsion formulations containing those components."¹ *Answer*, p. 5. However, the Office

¹ Appellants note that the Office mistakenly alleges that Appellants have misquoted its arguments in the Office Action dated February 12, 2002. *Answer*, 5. In the Appeal Brief, the Appellants stated that "the Examiner *refutes* . . . 'that a routineer would pick the cationic polysaccharide only and leave out the

does allege alternatively that a rejection based on the addition of both *Restle*'s claimed components into the compositions of *Ziegler* would be proper because the present invention uses the term "comprising" in the claims. *Answer*, p. 5. Appellants contend that the Office has not demonstrated how the cited references suggest either of the proposed combinations regardless of the presence of "comprising."

For example, *Ziegler* neither teaches nor suggests isolating the cationic polysaccharides and adding them to other compositions. Rather, *Ziegler* teaches a specific combination of a quaternary ammonium functionalized phosphate ester and a cationic polysaccharide, *the combination as a whole being useful for moisture retention and enhanced stability of its compositions*. See col. 1, lines 55-65; see also *Appellant's Brief* dated November 7, 2002, page 17-18, for detailed discussion.

Thus, it is still unclear why one would seek the benefits of individual components as urged by the Office where the reference only exalts the benefits of the combination. For at least this reason, the teachings of *Ziegler* taken alone or coupled with *Restle* fail to explicitly or even implicitly teach or suggest the claimed invention.

Further, *Ziegler* does not teach or suggest the usefulness of the presently claimed cationic polymer as a thickener, which further undermines the Office's

quaternary ammonium functionalized phosphate esters' of *Ziegler*." *Appeal Brief*, p. 12 (emphasis added). Thus, contrary to the Office's assertion, Appellants clearly understood the grounds for the rejection stated in the Office Action.

logic for combining the cited references. The specification of the present application teaches the following:

“there is . . . a need for a thickening system which can conventionally thicken, or even gel, a composition in the form of an oil-in-water nanoemulsion [which] minimiz[es] any possible influence that it may have on the cosmetic properties [, i.e., stability and transparency] of said compositions. The inventors have discovered, *unexpectedly*, that oil-in-water nanoemulsions comprising oil globules with an average size of less than 150 nm comprising at least one amphiphilic lipid can be thickened with *at least one cationic polymer*”

Specification, p. 3, lines 17-22 (emphasis added). Thus, Appellants successfully discovered a cationic polymer thickening system that had a minimizing effect on stability and transparency.

Neither the *Ziegler* nor the *Restle* reference suggests the use of the presently claimed cationic polymer as a thickener. Indeed, *Ziegler* discloses other thickeners that can be used in its composition, such as xanthan gum and sodium carboxymethyl cellulose. See col. 8, lines 27-31. Thus, *Ziegler* does not remotely suggest such a cationic polymer thickening system, let alone its claimed combination of a quaternary ammonium functionalized phosphate ester and a cationic polysaccharide.

Appellants recognize that the motivation needed to arrive at the claimed invention can differ from that relied on by the invention. *In re Linter*, 458 F.2d 1013, 1016 (C.C.P.A. 1972).² However, Appellants submit that this evidence not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

² In *Linter*, the court affirmed the Board of Patent Appeals and Interferences decision of obviousness. However, in that case, the prior art not only disclosed

only further highlights the Office's flawed logic, but actually undercuts the Office's assertion that its conclusion of obviousness is not based upon improper hindsight reasoning. *Answer*, p. 6. The Office has clearly "gleaned" knowledge from the Appellants' disclosure to reconstruct the claimed invention - while glossing over, if not ignoring, the required showing of "clear and particular" evidence of a motivation to combine.

The Office has done nothing more than cite references to show that the elements of the present invention are known. However, this does not suffice to establish a *prima facie* case. As the Board of Patent Appeals and Interferences has stated "[t]o support the conclusion that [a] claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Office must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious" *In re Clapp*, 227 U.S.P.Q. 972, 973 (B.P.A.I. 1985). In this case, the Office has done neither and therefore the rejection should be reversed and withdrawn.

2. The Office Failed to Address Why One Skilled in the Art Would Have a Reasonable Expectation of Success in the Proposed Modification

The Office disagrees with Appellants' argument that "the disclosure of the specifications show unpredictability in adding the cationic polymers to nanoemulsions." *Answer*, p. 7. The Office alleges that "the disclosure in the

all the claimed components but also disclosed that these components could be used together. *Linter*, 458 F.2d at 1007. Thus, *Linter* is clearly distinguishable

specification does not overcome the presumption of obviousness that a routineer who reads the Restle and Ziegler references would have motivations to combine the Ziegler cationic polymers to the Restle nanoemulsions." *Id.*

Appellants respectfully disagree. First, the Office never directly addresses the argument made in the Appeal Brief regarding the unpredictability of adding polymers to nanoemulsions. See *Appeal Brief*, p. 18-20. Second, it appears from the Examiner's Answer that the Examiner bases her rejection on a motivation to combine. But this argument had nothing to do with a motivation to combine. Rather, Appellants argued that the Office has presented no evidence on why one skilled in the art would have had a reasonable expectation of success in the proposed modification. Thus, Appellants maintain their arguments of record.

C. Group 3: Claims 23-29

The Office has maintained the rejection of claims 23-29 and 63 under 35 U.S.C. § 103(a) as being unpatentable over *Restle*, *Ziegler*, and further in view of European Patent No. 0780 114 A1 to *Simonnet* ("*Simonnet*"). *Answer*, p. 7-8. Appellants maintain that Office has yet to establish a prima facie case of obviousness with respect to this rejection as well.

The Office refutes the Appellants' assertion that "the [*Simonnet*] rejection fails to provide motivation to use the ionic amphiphilic lipids." *Answer*, p. 7. The Examiner alleges that "[ionic amphiphilic lipids are] specifically indicated in Example 3, which employs disodium salt of N-stearyl-L-glutamic acid in a

from the present facts.

nanoemulsion" *Id.* at p. 8. Based on this allegation, the Office concludes that "[t]he burden was on applicants to show with clear and convincing evidence how the present invention is nonobvious or produces unexpected results over this evidence." *Id.* However, the Office has still not set forth adequate evidence to shift the burden to Appellants.

Even if Example 3 discloses the use of ionic amphiphilic lipids, this still does not render the present invention obvious. As detailed in Appellants' Brief and discussed *infra*, one of ordinary skill in the art would not have been motivated to modify the teachings of *Restle* and *Ziegler*. *Simmonet*, as relied on by the Office for its alleged teaching of anionic amphiphilic lipids and turbidity of the claimed invention, does not cure the fundamental deficiencies of the underlying references. Thus, the Office's alleged modification cannot render the presently claimed invention obvious. For at least this reason and the reasons set forth in the Appeal Brief filed November 2, 2002, at pages 20-23, the rejection should be reversed and withdrawn.

D. Group 4: Claim 20

The Office has maintained the rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over *Restle*, *Ziegler*, and *Simmonet* and further in view of U.S. Patent No. 5,716,418 to Matzik et. al ("*Matzik*"). Appellants respectfully disagree for reasons set forth above, as well as in the Appeal Brief filed on November 7, 2002, at pages 23-25, and ask that this rejection be reversed and withdrawn.

E. Group 5: Claims 64-67

The Office has maintained the rejection of claims 64-67 under 35 U.S.C. § 103(a) as being unpatentable over *Restle*, *Ziegler*, *Simonnet*, *Matzik*, and further in view of *Decoster*. Appellants respectfully disagree for reasons set forth in the Appeal Brief filed on November 7, 2002, at pages 25-27, and ask that this rejection be reversed and withdrawn.

II. Conclusion

For reasons of record and the reasons set forth above, Appellants respectfully request that each rejection be reversed and withdrawn. The Office has failed to demonstrate at least two of the criteria needed to establish a prima facie case of obviousness. Specifically, the Office has failed to set forth any evidence that one of ordinary skill in the art would have been motivated to make the Office's proposed modifications and even if such a modification was made that it would have led to a reasonable expectation of success fully obtaining that which Appellants have discovered and now claim.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 31, 2003

By: 

Louis M. Troilo
Reg. No. 45,284

Res. No.
44,455

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com